

### **REMARKS**

The Applicants' representative has carefully reviewed and considered the Office Action mailed on September 10, 2003, as well as the references cited therewith. Claims 1 and 3 are amended, claim 2 is canceled, and claim 24 has been added. The Applicants acknowledge that claims 9-10, 12-13, and 16-18 have been withdrawn from consideration. As a result, claims 1, 3-8, 11, 14-15, and 19-24 are now pending in this Application.

### **Drawings**

An objection has been made to the drawings, based on non-uniform line thickness and non-standard lettering. Formalized drawings are enclosed and should serve to satisfy the concerns expressed by the Office with respect to the originally-filed, hand-written drawings. No amendments have been made, and no new matter has been added.

### **§102 Rejection of the Claims**

Claims 1, 2, 4-8, 11, 14, 15, 19, 20, 22 and 23 were rejected under 35 USC § 102(b) as being anticipated by Sass et al. (U.S. 5,418,878, hereinafter "Sass"). First, the Applicants do not admit that Sass is prior art, and reserve the right to swear behind this reference in the future. Second, because the Applicants assert that Sass does not disclose the identical embodiments claimed, the Applicants respectfully traverse this rejection.

Independent claim 1 has been amended to recite "a first electrically conductive shield surrounding ... first ... optical signal conductors and ... electrical signal conductors", as well as "a second electrically conductive shield surrounding ... second ... optical signal conductors and ... electrical signal conductors". Sass does not disclose multiple shielding elements surrounding separated groups of optical and electrical conductors. Thus, claim 1 (and claims 3-7 that depend from claim 1) should be in condition for allowance over the cited art.

Independent claim 8 was not specifically addressed in the Office Action. However, it is respectfully noted that no optical and electrical terminations of a connector are taught by Sass. Therefore, claim 8 should be in condition for allowance over the cited art.

It is asserted in the Office Action that "it is inherent to have a connector" with respect to claims 11 and 15. However, as has already been noted, no connector is taught by Sass. Further, if the Office relies on inherency then, as recited in MPEP § 2112, "... the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). It does not appear that any such basis has been provided. In fact, the illustrations of Sass explicitly show that connectors are not inherent in the presence of electrical and optical conductors. Therefore claims 11 and 15 should be in condition for allowance over the cited art.

Independent claim 14 was not specifically addressed in the Office Action. However, it is respectfully noted that no circuit board optical and electrical signal terminations are taught by Sass. Therefore, claim 14 should be in condition for allowance over the cited art.

It is asserted in the Office Action that "it is inherent to have circuit board" with respect to claim 19. However, as has already been noted, if the Office relies on inherency then, as recited in MPEP § 2112, "... the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). It does not appear that any such basis has been provided. In fact, the illustrations of Sass explicitly show that circuit boards are not inherent in the presence of electrical and optical conductors. Therefore claim 19 (as well as claims 20-23 that depend from it) should be in condition for allowance over the cited art.

New claim 24 has been added, and incorporates a limitation originally contained in amended claim 3. No new matter has been added, and claim 24 should be in condition for allowance over the cited art due to the novelty imparted by claim 1, from which it depends.

It is respectfully noted that anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH*

*v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131. Since Sass does not teach a shielding mechanism, a connector, terminations, and signal communication systems as claimed by the Applicants, in a manner that is identical to the subject matter of the embodiments claimed, the rejection of claims 1, 4-8, 11, 14, 15, 19, 20, 22 and 23 under § 102 is improper. Reconsideration and allowance are respectfully requested.

*Allowable Subject Matter*

Claims 3 and 21 were objected to as being dependent upon a rejected base claim, but indicated to be allowable if rewritten in independent form (including all of the limitations of the base claim and any intervening claims). Claim 3 has now been amended, solely to accommodate to revised wording of claim 1, and not for reasons related to patentability. Claims 3 and 21 should be allowable over the cited art due to the additional novelty they impart, and for the reasons given above.

**CONCLUSION**

The Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicants' attorney, Mark Muller (210-308-5677), or the undersigned representative (612-349-9592), to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

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Date Nov. 10, 2003

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Non-Fee Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 10<sup>th</sup> day of November 2003.

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